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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,326	07/26/2000	William G. Hubbard	047542/0197	8619

7590 06/11/2002  
Foley & Lardner  
Suite 3300  
330 North Wabash Avenue  
Chicago, IL 60611-3608

EXAMINER

STRZELECKA, TERESA E

ART UNIT PAPER NUMBER

1637

DATE MAILED: 06/11/2002

15

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/626,326

Applicant(s)

HUBBARD ET AL.

Examiner

Teresa E Strzelecka

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-41, 57-64, 66 and 70 is/are allowed.
- 6) ☒ Claim(s) 42-56, 65 and 67-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This Office action is in response to an amendment filed on January 9, 2002.
2. Claims 40-56, 65 and 69 do not have priority going back to any of the claimed priority applications, since the dehydrated composition was not described or suggested in any of them, therefore their priority date is July 26, 2000, the filing date of the application.

#### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 42-56, 65 and 67-69 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Neither the specification nor the priority applications provide a description of a process to form a dehydrated composition of claims 42-56, 65, and 67-69.

#### *Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 42-56, 65 and 69 are rejected under 35 U.S.C. 102(b) as being anticipated by Rhee et al. (U.S. Patent No. 5,324,775).

Rhee et al. teach biocompatible compositions comprising conjugates, liquid carriers and/or proteins. The conjugates comprise hydrophilic synthetic polymers, such as polyethylene glycol, and

Art Unit: 1637

polysaccharides, such as hyaluronic acid, hydroxyethyl cellulose, cellulose ether, etc. The conjugates are dehydrated to form a solid, then converted into particles or shaped into solid objects. The resulting material can be used in tissue augmentation (Abstract; col. 2, lines 1-67; col. 3, lines 1-32; col. 4, lines 48-58).

For use in treatment of bone or cartilage, the conjugates are combined with ceramic particles, made from hydroxyapatite or tricalcium phosphate (col. 6, lines 50-68; col. 8, lines 17-30). The bioconjugates can be also prepared in the form of sponges, by lyophilizing the aqueous slurry of the composition after conjugation (col. 28, lines 65-68).

7. No references were found teaching or suggesting claims 1-41, 57-64, 66-68 and 70. Claims 67 and 68 are objected to as being dependent on the rejected claim 42. The closest prior art, Leshchiner et al. (U.S. patent No. 5,143,724) teaches gel slurries formed from a polysaccharide (hyaluronan or hylan) gel in aqueous solution, but do not teach the gel having a viscosity between 20,000 to 350,000 centipoise, or the gel as a carrier for a biocompatible tissue augmentation material.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teresa E Strzelecka whose telephone number is (703) 306-5877. The examiner can normally be reached on M-F (8:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached at (703) 308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 305-3014 for After Final communications.

Application/Control Number: 09/626,326

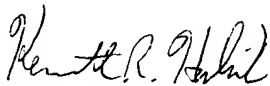
Page 4

Art Unit: 1637

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

TS  
June 5, 2002

TS

  
KENNETH R. HORLICK, PH.D.  
PRIMARY EXAMINER

6/5/02